

REMARKS

This responds to the Office Action mailed on December 5, 2005.

Claims 1, 9, and 10 have been amended. Claim 8 has been canceled. No claims have been added. As a result, claims 1-7, 9, 10, and 36-47 are pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

Amendments to Claims 1, 8, and 9

Claims 1, 8, and 9 have been amended. No new matter has been introduced.

Claim 1 has been amended by incorporating the subject matter of dependent claim 8, and claim 8 has accordingly been canceled.

The dependency of claims 9 and 10 has been changed from claim 8 to claim 1.

Rejection of Claims 1-10 and 36-47 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting over Claims 1-25 of U.S. Patent No. 6,452,247

Claims 1-10 and 36-47 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-25 of Applicant's U. S. Patent No. 6,452,247.

The subject matter disclosed and claimed in U. S. Patent No. 6,452,247 was invented by the same inventor and is assigned to the same assignee as the subject matter disclosed and claimed in the present application. As indicated on page 1, lines 5-8 of the present application, the present application is a divisional application of Serial No. 10/238,539, which in turn is a divisional application of Serial No. 09/444,608, which matured into U. S. Patent No. 6,452,247.

In a Restriction Requirement dated January 28, 2002, claims 1-30 of Serial No. 09/444,608 were restricted into two groups. Group I comprised claims 1-25, and Group II comprised claims 26-30. The Restriction Requirement stated that the inventions were distinct, each from the other.

In Applicant's Response to Restriction Requirement dated February 14, 2002, Applicant elected Group I (claims 1-25). Applicant canceled claims 26-30 and reserved the right to file them in one or more divisionals at a later date.

Prior to the issue date (September 17, 2002) of Serial No. 09/444,608, a divisional application Serial No. 10/238,539 was filed (September 10, 2002). Serial No. 10/238,539 included claims 1-30. Claims 1-15 were based upon non-elected claims 26-27 of Serial No. 09/444,608, and claims 16-30 were based upon non-elected claims 28-30 of Serial No. 09/444,608.

In a Restriction Requirement dated February 24, 2003, claims 1-30 of Serial No. 10/238,539 were restricted into two groups. Group I comprised claims 1-15, and Group II comprised claims 16-30. The Restriction Requirement stated that the inventions were distinct, each from the other.

In Applicant's Response to Restriction Requirement dated March 24, 2003, Applicant elected Group I (claims 1-15). Applicant canceled claims 16-30 and reserved the right to file them in one or more divisionals at a later date.

The present application represents such a divisional. The present application was filed (April 20, 2004) before its parent Serial No. 10/238,539 issued (April 27, 2004). Claims 1-30 of the present application are based upon non-elected claims 16-30 of Serial No. 10/238,539, which in turn are based upon non-elected claims 28-30 of Serial No. 09/444,608.

35 U.S.C. §121, third sentence, states:

“A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.”

The Examiner is also referred to MPEP §804.01 for additional commentary on the prohibition against a double patenting rejection, using a patent issuing on an application with

respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement.

For the above reasons, Applicant respectfully requests that the rejection of claims 1-7, 9, 10, and 36-47 under the judicially created doctrine of obviousness-type double patenting over claims 1-25 of Applicant's U. S. Patent No. 6,452,247 be withdrawn.

Rejection of Claims 1-4 and 7
under 35 U.S.C. §102(e) as Anticipated by Stacey

Claims 1-4 and 7 were rejected under 35 U.S.C. §102(e) as being anticipated Stacey (U.S. 6,169,320). Applicant does not admit that Stacey is prior art and reserves the right to swear behind Stacey as provided for under 37 C.F.R. §1.131.

The rule under 35 U.S.C. §102 is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Regarding independent claim 1, as amended, Stacey fails to disclose all of the structural elements recited. For example, nothing could be found in Stacey disclosing an integrated circuit comprising an inductive element fabricated in such a manner that, in forming a first conductive layer, the first conductive layer comprises magnetic material.

For the above reasons, independent claim 1 should be found to be allowable over Stacey, and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(e) as anticipated by Stacey be withdrawn.

Those claims that depend, directly or indirectly, from claim 1 and incorporate all of the limitations therein are also asserted to be allowable for the reasons presented above.

Additional Elements and Limitations

Applicant considers additional elements and limitations of claims 1-7, 9, 10, and 36-47 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

Conclusion

Applicant respectfully submits that claims 1-7, 9, 10, and 36-47 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DONALD S. GARDNER

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Attorneys for Intel Corporation
P.O. Box 2938
Minneapolis, Minnesota 55402
(612) 349-9592

Date Jan 5, 2006

By Ann M. McCrackin
Ann M. McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of January 2006.

Amy Moriarty

Name

Signature

